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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,248	03/04/2002	Michel Philippe	05725.1032-00	7789

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EXAMINER

CRIARES, THEODORE J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,248	Applicant(s) PHILIPPE ET AL.	
	Examiner Theodore J. Criares	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
 4a) Of the above claim(s) 2-13 and 18-27 is/are withdrawn from consideration.
 5) ☒ Claim(s) 31 and 32 is/are allowed.
 6) ☒ Claim(s) 1, 14-17 and 28-30 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CLAIMS 1-32 ARE PRESENTED FOR EXAMINATION

Applicant's arguments filed May 6, 2004 have been fully considered but they are not persuasive.

Applicants information with respect to the rejection under 35 U.S.C. 102(a) being applied is acknowledged , but it is to be understood that the rejection can be made under (a) or (b). The rejection under 102(a) gives the applicants the opportunity to swear behind the reference with a proper declaration. The case law under Novitski as cited in the previous Office Action renders the claim anticipated since the claim recites the term "prevention". It is suggested that this term be withdrawn from the claim to further the prosecution of the subject application. In view of the above the following is applicable:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-13 and 18-27 are withdrawn from consideration.

Claim Rejections - 35 USC § 102

Claims 1, 14-17 and 28-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Phillippe et al. (WO 99/49837, hereinafter referred to as '937).

'937 teaches in the abstract applicants' claimed compounds used for strengthening and care of keratinous fibre. The application of applicants' claimed known compounds, as taught by '937, would inherently **prevent** drying out keratin fibres as claimed by applicants. In other words once the compounds are used for a different

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purpose they would be preventing any other claimed condition. See *Ex parte Novitski* 26 USPQ2d 1389.

DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,14-17 and 28-30 are rejected under the judicially created doctrine of double patenting over claims 23, 24, 25, 27, and 28 of U. S. Patent No. 6,585,962 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is obvious from the teachings in the patent and claims therein. The claims of the patent are drawn to applying applicants' compounds to lips (claim 23), in the form of lipstick (claim 24), skin (claim 25), protective body milk (claim 27), and a night product (claim 28). The difference between these claims and applicants' claims is that applicants are claiming a moisturizing feature. However, the skilled artisan would have been motivated to use applicants' known claimed compounds to moisten the skin since the compounds were

previously disclosed in the manner set forth above which are used to keep the skin and lips moist.

This obvious type double Patenting rejection is deemed proper.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicants argue that the claims in '962 differ from those of the application since the present claims are broader than those in the instant application. However, the species of the patent are within the scope of the generic claim of the present application. The claims in '962 and the claims in the application give protection to common subject matter. The generic compounds in the application include the species claims of the application.

The applicants argue that the claims of '962 differ from those of the instant application. However, the claims in the application define an obvious variation of the invention claimed in the patent since the compositions taught in the patent can be applied to lips in the form of lipstick and body in the form of body milk. The reason for these cosmetics as taught in the patent is to improve the moisture of skin and mucous and the claims in the patent and application are covering obvious type subject matter.

Claims 31 and 32 are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Criares whose telephone number is (571)

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272-0625. The examiner can normally be reached on 6:30 A.M. to 5:00P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Theodore J. Criares
Primary Examiner
Art Unit 1617

8/10/04

tjc